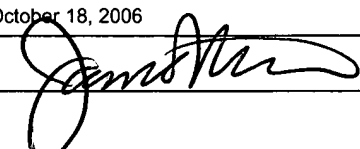


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 48748US019	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>October 18, 2006</u> Signature <u></u> Typed or printed name <u>James D. Withers</u>		Application Number 10/655,331	Filed September 4, 2003
		First Named Inventor Falaas	
		Art Unit 1711	Examiner Tran, T.T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

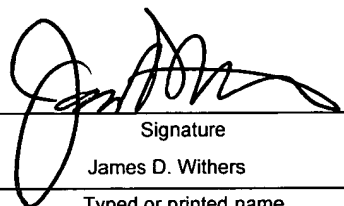
This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record. 40,376
Registration number _____
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature
James D. Withers

Typed or printed name
678-565-4748

Telephone number
October 18, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Patents

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
FALAAS) Art Unit: **1711**
)
Serial No.: **10/655,331**) Examiner: **Tran, T.**
)
Filing Date: **September 04, 2003**) 3M Matter No.: **48748US019**

For: **METALLIZED FILM AND DECORATIVE ARTICLES MADE**
THEREWITH

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal review of the present application for at least the following reasons:

1. International Patent Publication No. WO91/10562 to Ochi et al. (hereinafter, "Ochi") fails to anticipate previously presented claims 17-18, 21, 23-24, 35-37 and 39.

As discussed in Applicants' April 24, 2006 Amendment and Response and in Applicants' October 11, 2005 Amendment and Response, Ochi fails to disclose an article comprising a polyurethane substrate derived from an aqueous urethane dispersion, and therefore, cannot anticipate claims 17-18, 21, 23-24, 35-37 and 39.

2. Examiner Tran is not properly construing the claim features of previously presented claims 17-18, 21, 23-24, 35-37 and 39.

As discussed in Applicants' April 24, 2006 Amendment and Response and in Applicants' October 11, 2005 Amendment and Response, all claim features must be considered when determining whether a given reference anticipates a claim. Examiner Tran appears to ignore the claim feature "a polyurethane substrate derived from an aqueous urethane dispersion." Examiner Tran's justification for ignoring this claim feature is that Examiner Tran believes this language to product-by-process language.

Applicants submit that the language is not product-by-process language, and recites chemical construction of the recited polyurethane substrate. However, even if the language is considered to be product-by-process language, the language must be considered in an anticipatory analysis.

3. Examiner Tran is ignoring the evidentiary data of the previously submitted December 21, 2001 Declaration of Dr. Falaas.

Applicants previously submitted a December 21, 2001 Declaration of Dr. Falaas, which clearly demonstrates that polyurethane layers formed by aqueous dispersions are distinguishable from polyurethane layers formed from solution. The previously submitted Declaration of Dr. Falaas clearly states that polyurethane substrates derived from an aqueous urethane dispersion have a much higher elongation and tear strength properties when compared to polyurethane substrates derived from a solvent-based solution. See paragraphs (7), (8) and (10) of the Declaration.

4. Examiner Tran has failed to make a *prima facie* case of obviousness in view of the proposed combinations of any of the teaching of Ochi, the teaching of Dunning, and the teaching of Kunevicius.

As discussed in Applicants' April 24, 2006 Amendment and Response and in Applicants' October 11, 2005 Amendment and Response, the art of record fails to teach or suggest the desirability of modifying the articles of Ochi and/or Dunning as suggested by Examiner Tran. See, *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).